

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Alberth, Jr. et al.)
For: A Method and System for)
Maintaining Registration)
Information for Multiple)
Communication Areas)
Serial No.: 10/749,819)
Filed: December 31, 2003)
Examiner: Levitan, D.)
Art Unit: 2616)

Pre-Appeal Brief Request for Review

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Applicants hereby request review of the final rejection in the above-identified application. No amendments are being filed with this request. The present request is being filed in conjunction with a notice of appeal. The review is being requested for the reasons stated below, which frames the issue to be considered as part of the pre-appeal review process.

The Examiner continues to reject claims 1-6, 8-14 and 16-21, and more specifically, the Examiner continues to reject claims 1, 3-6, 9, 10, 12-14, 16 and 21, under 35 U.S.C. §103(a), as being unpatentable over Selby, US Patent No. 4,876,738, in view of one or more of Chen et al., US Patent No. 6,922,561; Purnadi et al., US Patent No. 6,708,031; Frid et al., US Patent No. 6,560,239; and Lawrence, US Patent No. 6,628,935. However contrary to the Examiner's assertions, the references fail to make known or obvious each and every feature of the claims. Consequently, the applicants would contend that the same has not been properly shown to be anticipated and/or made obvious, and would respectfully request that the Examiner reconsider the rejection and withdraw the same.

In rejecting the claims, the Examiner has correctly identified that Selby, '738, minimally fails to teach associating each communication area with one of a plurality of paging groups, associating and registering with a different paging group, and a paging group area detect module. However contrary to the assertions of the Examiner, Chen et al., '561, fails to account for the noted deficiencies, such as where the paging group area detect module detects the wireless communication device entering a new paging group area, and where if the new area is associated with a different paging group, registering in the new communication area regardless as to whether a registration from a prior presence in the new communication area is still retained (claims 1 and 12).

Alternatively, Chen et al., '561, detects a number of cells in a current cell list which reaches a predetermined limit (see col. 10, lines 1-5), which may or may not coincide with detection of an entry into a new paging area. In the example provided in the reference no association is taught or suggested. In any event, Chen et al., '561, is silent as to registering in the new communication area regardless as to whether a registration from a prior presence in the new communication area is still retained. In fact, if one is entering a new communication area, the new communication area is only added if it not already included in the CURRENT_CELL_LIST or the PREV_CELL_LIST. Furthermore, it is only after a new cell is added to the CURRENT_CELL_LIST that a MAX_NUM_CELLS which has not previously been exceeded could be newly exceeded, which would prompt a registration. Correspondingly, a registration that is prompted based upon exceeding a predetermined limit for the MAX_NUM_CELLS could only be achieved, after having added a new cell to the CURRENT_CELL_LIST, which was not already present in the CURRENT_CELL_LIST or the PREV_CELL_LIST (see col. 9, line 59 to col. 10, line 40). Because a registration is only prompted when the number of cells in the CURRENT_CELL_LIST exceeds the MAX_NUM_CELLS, and a new cell is only added to the CURRENT_CELL_LIST, when the new cell is not already present in either the CURRENT_CELL_LIST or the PREV_CELL_LIST, a registration could not occur based upon entering a new communication area having an association with a new paging group regardless as to whether a registration from a prior presence in the new communication area is still retained, as provided by independent claims 1 and 12. Consequently Chen et al., '561, fails to account for each and every feature associated with an element that has been acknowledged as being absent from Selby, '738, the principal reference.

As a result Chen et al., '561, similarly fails to make known or obvious the feature, and therefore the combination of Selby, '738, and Chen et al., '561, similarly could not make known each and every feature of the claims 1 or 12, and/or any of the claims, which depend therefrom.

Furthermore, with respect to claim 11, and the Examiner's assertion that Lawrence, '935, makes known the deletion of messages upon a change in power states, upon review of Lawrence, '935, such an assertion can not be supported, nor does the teaching relate to a context consistent with the claimed invention. More specifically, contrary to the assertions of the Examiner, Lawrence, '935, fails to teach the deletion of messages, but alternatively teaches the deactivation of a memory exceed indicator (see col. 2, lines 12-34). In the particular embodiment discussed, even though the memory exceed indicator is deactivated upon power up, if undeliverable messages are subsequently detected the memory exceed indicator will be re-activated (see col. 6, lines 16-40).

Furthermore the teachings of the reference relate to a system associated with SMS type paging messages, which are not the same as registration information associated with a previous presence in a new area. Even if the reference were to teach the deletion of a message upon power up, which it does not, the Examiner is not allowed to allege a teaching which goes beyond the actual teaching. In other words the nexus has not been shown between an e-mail type textual message sent to a user and registration information. The Examiner is not allowed to expand the teaching beyond what the reference actually teaches, through the use of creative re-labeling of the elements associated with the actual teaching (a re-labeling that is not part of the language of the original reference). Nevertheless, the Examiner can not even show that any information is deleted upon power up (even the memory exceed indicator is not deleted, alternatively its value is only changed). As a result, the references being relied upon in support of the rejection of claim 11, can not be said to make known or obvious each and every feature of claim 11.

The other references being relied upon by the Examiner fail to account for the above noted deficiency. In view of the above remarks, the applicants would respectfully request that the Examiner's final rejection of the claims be withdrawn, as failing to make known or obvious each and every feature of the claims.

Respectfully submitted,

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